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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/813,585	03/30/2004	Bertram Rupietta	RUPIETTA ET AL. - 1	4312
25889	7590	10/19/2005	EXAMINER	
WILLIAM COLLARD COLLARD & ROE, P.C. 1077 NORTHERN BOULEVARD ROSLYN, NY 11576			DANIELS, MATTHEW J	
			ART UNIT	PAPER NUMBER
			1732	

DATE MAILED: 10/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/813,585	RUPIETTA ET AL.	
	Examiner	Art Unit	
	Matthew J. Daniels	1732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 30 March 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 1-13 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 14-17 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/30/04</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-13, drawn to an apparatus, classified in class 425, subclass 63.
 - II. Claims 14-17, drawn to methods, classified in class 264, subclass 34.
2. Inventions II and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus can be used in another and materially different process, such as application of a polymeric sheet to the interior of lead pipe.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, recognized divergent subject matter, and because the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Mrs. Richter on 6 October 2005, a provisional election was made with traverse to prosecute the invention of Group II, claims 14-17. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-13 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.
5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the

currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. **Claim 14** is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 15 of copending Application No. 10/813,605 in view of Haddy (USPN 4690631). Although the conflicting claims are not identical, they are not patentably distinct from each other for the following reasons:

The language of Claim 14 of the instant application and Claim 15 of the '605 application appears to be the same except for the presence of a turntable in the '605 application. However, turntables are known and obvious in the art of forming concrete pipes, and this aspect is taught by Haddy (Fig. 1, Item 16). It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Haddy into the instant application in order to provide a simple and efficient means for moving pipe between stations.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. **Claim 15** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In this claim, it is unclear what is being performed and how it materially affects the claimed method because the step occurs after removal of the concrete pipe from the compacting tool and from the mold.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 14 and 15** are rejected under 35 U.S.C. 103(a) as being unpatentable over Ottmann (USPN 4041118). As to **Claim 14**, the “means” language of the claim is not interpreted as having invoked 35 USC 112, sixth paragraph, because part (A) of the three-prong

analysis set forth in MPEP 2181 (I) is not met. Ottmann teaches a method for the production of a multi-layer concrete pipe, comprising the following steps:

moving a mold mantle, which stands essentially vertically, into a stand (Fig. 1, Items 10 and 12, the mold is moved with a hoist, Fig. 4, Item 50);

filling the mold mantle with first concrete mixture by means of a first charging system (Fig. 1, Item 22);

distributing and compacting the concrete mixture in the mold mantle by means of a rotating and vertically displaceable compacting tool (Fig. 1, Items 20, 18, 16, 24);

moving the mold mantle, which stands essentially vertically, out of the stand and removing the concrete pipe from the mold (Ottmann's method uses a hoist, *supra*);

wherein before the concrete pipe is removed from the mold, a second concrete mixture filled into the mold mantle, said mold mantle standing essentially vertically, and a diameter of the compacting tool for distributing and compacting the second concrete mixture is reversibly reduced (3:22-45). Ottmann is silent to pivoting the mold into or out of the stand. However, this limitation does not materially affect the claimed method of making the concrete pipe because it is only a positioning step which does not affect the concrete pipe. However, Ottmann's teaching of a hoist would render obvious the aspect of pivoting because pivoting of the mold may be performed in order to align the mold and second tool to ensure that the second tool does not damage the first layer, or because hoisting cranes often pivot, and it would have been obvious to pivot Ottmann's hoist during positioning. As to **Claim 15**, note the rejection of Claim 15 above under 35 USC 112, second paragraph. It is the Examiner's position that this claim does not materially affect the claimed method for producing a multi-layer pipe because it occurs after the

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concrete pipe is removed from the compacting tool and from the mold (mantle). Although Ottmann appears to be silent to the claimed limitation, it would have been *prima facie* obvious in view of Ottmann's teaching that the apparatus may be expanded or contracted selectively (2:36-46). It would have been *prima facie* obvious to one of ordinary skill in the art at the time of the invention to expand the compacting tool after removal of the concrete pipe to clean the tool and the vertical tool seam prior to the next molding cycle.

9. **Claim 16** is rejected under 35 U.S.C. 103(a) as being unpatentable over Ottmann (USPN 4041118) in view of Gowing (USPN 2533579). Ottmann teaches the subject matter of Claim 14 above under 35 USC 103(a). **As to Claim 16**, Ottmann appears to be silent to the claimed aspects of after distributing the first concrete mixture and compacting it, changing a direction of rotation. However, this aspect is known in the art and is taught by Gowing (6:18-23). It would have been *prima facie* obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Gowing into that of Ottmann in order to provide an extremely smooth (6:21) and hard inner surface (6:37-38) lacking large cavities (6:44), and being generally impervious (6:46).

10. **Claim 17** is rejected under 35 U.S.C. 103(a) as being unpatentable over Ottmann (USPN 4041118) in view of Fosse (USPN 4340553). Ottmann teaches the subject matter of Claim 14 above under 35 USC 103(a). **As to Claim 17**, Ottmann is silent to the claimed limitation. However, Fosse teaches that rotation speed is a result-effective variable (1:45-52), depending on whether metering or finishing is being performed (1:36-41). In view of Fosse's teachings, it

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would have been *prima facie* obvious to optimize and change rotation speed depending on the desired effect of the compacting process (metering or finishing). See MPEP 2144.05 II and *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Daniels whose telephone number is (571) 272-2450. The examiner can normally be reached on Monday - Thursday, 7:30 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianni can be reached on (571) 272-1196. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJD 10/11/05

MJD



**MICHAEL P. COLAIANNI
SUPERVISORY PATENT EXAMINER**